

REMARKS

This Amendment, submitted in response to the Office Action dated February 5, 2004, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-28 are all the claims pending in the application.

Claims 1, 4-7, 8, 9 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mack, II et al. (USP 6,510,325; hereafter "Mack") in view of newly cited Alperovich et al. (USP 6,317,609; hereafter "Alperovich"). Claims 10-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mack in view of Alperovich and Erkkila et al. (USP 6,480,724; hereafter "Erkkila"). Claims 15-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mack in view of Alperovich, Erkkila and newly cited Cariffe et al. (USP 6,201,548; hereafter "Cariffe"). Claims 23-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over newly cited Wilska et al. (USP 6,427,078) in view of Cariffe. Applicant respectfully traverses the prior art rejections.

With regard to independent claim 1, the Examiner now cites Alperovich for allegedly teaching "a system and method for a portable communication terminal (figure 3) to take a still digital image, store the image and display the stored or received still image for selection and transmission to another communications terminal through the [I]nternet or landline between mobile switching centers (figure 4, column 4, line 22 to column 5, line ⁵⁹~~29~~)." Further, the Examiner contends "[i]t would have been obvious to ... realize in the equipment of Mack the digital still picture transmission and reception methods of Alperovich to send and receive

pictures between two radiotelephones for enjoyment and other business applications.” (Office Action at page 4).

By this Amendment, Applicant has amended independent claim 1 to recite the communicating device “transmits and receives still image data and character data corresponding to the still image data” and “the display control device controls the image displaying device and the character displaying device to simultaneously display the still image on the image displaying device and the character corresponding to the still image on the character displaying device.”¹ That is, claim 1 now requires that the still image and the character are related to each other and simultaneously displayed. For example, the character(s) displayed on the character display device may be a comment and/or an explanation regarding the still image displayed on the image display device.

Applicant respectfully submits that Mack and Alperovich do not teach or suggest these features of amended claim 1.

Mack discloses a portable communication device including an integrated camera (21) for capturing video data, a character input device (keypad 2), multiple displays for displaying character and image data (displays 6, 20 and touch pad 43). Mack teaches that the portable communication device may be used as a standard mobile phone, a video phone or a data terminal. Further, Mack discloses that the portable communication device includes an anti-theft feature, wherein the camera captures a picture of a thief using the device, and the picture of the

¹ See Figs. 8 and 9 and the related description on page 8 of the specification.

thief is stored in a memory of the device and transmitted to a telephone company or police station.

Alperovich discloses a system and method for transmitting digital images and speech, wherein digital images and voice communications are transmitted over different paths between mobile stations. In particular, Alperovich teaches that digital images, which are captured and stored using a mobile station with an integrated camera, are transmitted over the Internet between mobile switching centers linked to communicating mobile stations, whereas voice communications are transmitted in the conventional manner over a cellular network and/or PSTN.

However, Applicant respectfully submits that the combined references do not teach or suggest simultaneously displaying the still image and the character corresponding to the still image. Rather, Mack simply discloses multiple display(s) which display an image and a character(s) by simply switching a screen.

Accordingly, Applicant respectfully submits that independent claim 1 should be allowable over the combination of Mack and Alperovich.

In addition, Applicant respectfully submits that the combined references do not teach or suggest a portable communication terminal which is configured to control the characteristics of an image to be displayed or printed, as recited claims 15 and 16.²

With regard to claims 15-22, the Examiner asserts that Cariffe discloses “a generic graphical interface under mouse control to select and operate various controls and editing

² By this Amendment, Applicant has rewritten claims 15 and 16 in independent form.

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routines for performing various imaging functions and print controls including Cut and Crop routines (column 2, lines 34-67).” Further, the Examiner alleges that “[i]t would have been obvious to ... further enhance the combination of Mack, Alperovich and Erkkila with the print controls as taught by Cariffe to provide image editing of the print.” (Office Action at page 7).

However, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103 since none of the cited references teach or suggest controlling the characteristics of an image to be displayed or printed in a portable communication terminal, as required by claims 15 and 16.

Cariffe simply discloses a graphical user interface for “performing various imaging functions” including “cut” and “crop” routines in a “typical PC-based image processing system” (i.e., a personal computer). While image editing is well known in the art, the use thereof in a portable data communication terminal is not taught or suggested by the prior art of record. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient to establish a *prima facie* case of obviousness. (See *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); and *Al-Site Corp. v. VSI Int’l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999)).

Thus, the mere fact that image editing is known in the art, as shown by Cariffe, is not in itself sufficient to establish a *prima facie* case of obviousness. Instead, there must be some

suggestion or motivation to modify or combine the reference teachings.³ However, in the present case, the Examiner has not provided any objective reasoning why one of ordinary skill in the art would have been motivated to modify the combination of Mack, Alperovich and Erkkila to incorporate controls to vary the characteristics of image displayed and output for printing. That is, Applicant respectfully submits the Examiner's alleged motivation ("to provide image editing of the print") is nothing more than impermissible hindsight reasoning which relies on the applicant's claimed invention as a "blueprint" to select features of prior art references to reconstruct the invention. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985).

Further, Applicant respectfully submits that none of the cited references teach or suggest the subject matter of dependent claims 20-22. Although the Examiner cites Cariffe for generally disclosing image editing, Carriffe does not teach or suggest:

- (1) producing image data by superimposing the character on the still image in accordance with the still image and the character displayed on the image displaying device and the character displaying device, as recited in claim 20,
- (2) designating a print-position of the character on a display of the image displaying device, as recited in claims 21 and 22, and

³ "To support the conclusion that the claimed invention is directed to obvious subject matter, either references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference." *Ex parte Clapp* 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

(3) superimposing the character on the still image at the print-position designated by the designating device, as recited in claim 22.

With regard to independent claim 23, the Examiner alleges that Wilska discloses all of the features of the claimed invention except for a display control device to display a print area of the image and to print the image within the print area displayed on the displaying device, which the Examiner contends is disclosed by Cariffe. Further, the Examiner asserts that “[s]ince Wilska points out the necessary software needs of the notebook computer include camera functions to record images (column 3, lines 54-65), it would have been obvious to ... modify the print control software drivers of Wilska with the photo editing methods of Cariffe to edit the image data prior to printing.” (Office Action at pages 7 and 8).

However, Applicant respectfully submits that claim 23 would not have been rendered obvious in view of Wilska and Cariffe because one of ordinary skill in the art would not have been motivated to modify the personal communication device of Wilska to include a display control device to display a print area of the image and to print the image within the print area displayed on the displaying device. In particular, Wilska teaches that in order to edit a picture, the picture is transferred from the personal communication device to “an external computer” and the edited picture can be transferred back to the personal communication device for storage and viewing (column 5, lines 1-3). Further, as discussed above, Cariffe simply discloses a graphical user interface for “performing various imaging functions” including “cut” and “crop” routines in a “typical PC-based image processing system” (i.e., a personal computer).

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Thus, based on the teachings Wilska and Cariffe, one of ordinary skill in the art would not have modified the personal communication device of Wilska to include the graphical user interface of Cariffe. Instead, one of ordinary skill in the art would have been led towards adding the image editing teachings of Cariffe to the external computer to which the personal communication device of Wilska transfers the picture for editing.

In view of the above, Applicant respectfully submits that claims 1-28 would not have been rendered obvious in view of the combined references.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


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